



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,339	12/15/2003	Rajesh K. Saini	2001-IP-005484U1P1	3700
71407	7590	09/23/2008		
ROBERT A. KENT P.O. BOX 1431 DUNCAN, OK 73536			EXAMINER LIGHTFOOT, ELENA TSOY	
			ART UNIT	PAPER NUMBER
			1792	
			NOTIFICATION DATE	DELIVERY MODE
			09/23/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ROBERT.KENT1@HALLIBURTON.COM
Tammy.Knight@Halliburton.com

Advisory Action

The amendment filed on September 3, 2008 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because the proposed amendment changes the scope of invention by not excluding polyester as an acid-releasing degradable material. Moreover, it is not clear why Applicants didn't amend the claims as a matter of right while responding to Non-Final Rejection mailed on 1/17/2008.

Response to Arguments

Applicant's arguments filed September 3, 2008 have been fully considered but they are not persuasive.

Specification

Applicants submit that the disclosure that "suitable acid-releasing degradable materials include polyesters; poly(orthoesters); aliphatic polyesters . . ." is acceptable even though 'polyesters' is generic to 'aliphatic polyesters.' Consequently, Applicants' description of both polyesters and aliphatic polyesters in a Markush listing is proper. Applicants respectfully request the withdrawal of this objection.

The Examiner agrees with this argument and withdraws the objection to the Applicants' specification.

Remarks Regarding Rejection of Claims Under 35 U.S.C. § 103(a)

Applicants submit that the Examiner has failed to establish that the combination of Nguyen and Wang teaches, suggests, or discloses coating the coating solution onto a particulate or gravel ***on-the-fly*** to create coated particulates or gravel, as required by independent claims 7 and 14. Applicants respectfully note that in this rejection, the Examiner has not even alleged that Nguyen or Wang teach this limitation. See Office Action ¶ 7. In a previous rejection the Examiner had cited portions of Nguyen to allege this teaching. (See Office Action mailed on January 17, 2008 at 5-6) (the cost of resin-coated proppant is high (See Nguyen, col. 2, lines 16-20), tackifying compounds can be in a solvent solution (See Nguyen, col. 5, lines 10-13), and an alcohol may be used as a solvent (See Nguyen, col. 5, lines 55-56)). Applicants argued in their

Art Unit: 1792

Response dated April 17, 2008 that the facts that the cost of resin-coated proppant is high, and that tackifying compounds can be dissolved in a solvent solution, such as alcohol, are insufficient to demonstrate the Nguyen teaches on-the-fly coating. The Examiner has yet to refute this argument. Therefore, because the Examiner has failed to demonstrate that the combination of Nguyen and Wang teaches, suggests, or discloses all of the elements of independent claims 7 and 14, the combination of Nguyen and Wang cannot obviate claims 7 and 14.

The Examiner respectfully disagrees with this argument. As was discussed in the Office Action mailed on January 17, 2008 at 5-6, Nguyen et al teaches that compared to resin-coated particles produced at high cost (in advance) in prior art for treating a subterranean formation (See column 2, lines 16-20), it is advantageous to use a particulate coated with a resin based *treatment material* by mixing the particulate with a solution of a resin based *treatment material* (claimed coating on-the-fly) in a solvent (See column 5, lines 10-13). Thus, Nguyen et al teaches a process *alternative* to prior art resin-coated particles. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have coated acid-releasing degradable material onto a particulate in ASA on-the-fly by mixing the particulate with a solution of acid-releasing degradable material in alcohol instead of coating it onto a particulate in advance since Nguyen et al teach that it is advantageous to use a particulate coated with a solution of a resin based treatment material on-the-fly.

Moreover, Nguyen teaches at column 4, lines 9-15, "The term "*simultaneous mixture*" will be understood to mean a mixture of components that are blended together in the **initial** steps of the subterranean formation treatment process". It is the Examiner's position that simultaneously blending together components in the *initial* steps of the subterranean formation treatment process reads on "real-time" mixing or claimed on-the-fly coating as described by the Applicants' specification in P25. If it could be argued that "simultaneous mixture" is prepared batch wise, it would be within the level of ordinary skill to operate a mixing process continuously on-the-fly.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

Art Unit: 1792

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy-Lightfoot, Ph.D.
Primary Examiner
Art Unit 1792

September 20, 2008

/Elena Tsoy Lightfoot/